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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,006	02/20/2002	Alan P. Bergelson	9732-024	1277
116	7590	03/22/2005	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			LEROUX, ETIENNE PIERRE	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,006

Applicant(s)

BERGELSON ET AL.

Examiner

Etienne P LeRoux

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/20/2002</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Status

Claims 1-20 are pending. Claims 1-20 are rejected as detailed below.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figures 7 and 8 are not legible. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: Figures 7-17 are omitted in the section Brief Description of the Drawings

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 10, 18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8, 10, 18 and 20 contain the trademark/trade name Visio. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe computer aided drafting software, and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 11-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts:
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the

Art Unit: 2161

“progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

In the present case, claims 1-6 are drawn to method, in particular, a method for creating a database for a form-based system. The claims are drawn solely to method steps for creating a database for a form(s) without the need for technology. Examiner maintains the claimed method steps can be mentally performed by an individual thinking about extracting information from a document and putting the information into a database. A user can manually superimpose graphical shapes over information in a document and then transfer the information enclosed by the shape into a database. During examination, the claims must be interpreted as broadly as their terms reasonable allow. Database is being interpreted as any large or extensive collection of data. The claimed method steps comprise steps which can be done manually and thus does not require technology. The rejection can be overcome by claiming computer-implemented method steps embodied on a computer-readable medium. The method steps of claims 1-6 become structurally and functionally interrelated to the medium and will be statutory since technology permits the function of the method steps to be realized.

Regarding claims 11-16, the software as claimed is not statutory because “software for” is at best, computer programs which are merely a listing of a predetermined set of instructions for solving a specific problem in a limited number of steps. The descriptions or expressions of software programs are not physical “things.” They are neither computer components nor statutory processes, as they are not acts being performed. The claimed software programs do not

Art Unit: 2161

define structural and functional interrelationships between elements of a computer which are required to realize the functionality of the claimed software. Examiner recommends that applicant claims a computer-readable medium encoded with computer instructions which define structural and functional interrelationships between the claimed software and the rest of the computer. The claimed software would thus be statutory as the software permits the computer's functionality to be realized.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result. In the present case, the invention is useful because information stored in a database can be retrieved, updated and again stored such that the updated information can be subsequently retrieved and displayed for the benefit of the user(s).

Art Rejection Precluded

Claims 8, 10, 18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Art Rejection is not included in this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub No US 2002/0176117 issued to Randall et al (hereafter Randall) in view of Pub No 2002/0032762 issued to Price et al (hereafter Price).

Claims 1 and 11:

Randall discloses receiving from a user [Fig 15, 205] a document, wherein said document comprises data regarding shapes or graphical objects [Visio drawings. etc, per paragraph 217] associated with information and populating a database [e-mail server 210, Fig 15, paragraph 217] from said information, using said data

Randall discloses the elements of claim 1 as noted above but fails to disclose information comprising one or more of the following: data type, data field size, and field location. Price discloses information comprising data type [Data Type Definition (DTD), paragraph 28]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Randall to include information comprising data type as taught by Price for the purpose of defining an XML schema [paragraph 28]. The skilled artisan would have been motivated to

Art Unit: 2161

improve the invention of Randall per the above such that Web developers and designers can create customized tags that offer greater flexibility in organizing and presenting information than is possible with the older HTML document coding system.

Randall discloses software [paragraph 217]

Claim 3:

The combination of Randall and Price discloses the elements of claim 1 as noted above and furthermore, Randall discloses wherein said document comprises a plurality of pages [paragraphs 82 and 83].

Claim 13:

The combination of Randall and Price discloses the elements of claim 11 as noted above and furthermore, Randall discloses wherein said document comprises a plurality of pages [paragraphs 82 and 83].

Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Randall and Price and further in view of US Pat No 5,894,310 issued to Arsenault et al (hereafter Arsenault).

Claim 2:

The combination of Randall and Price discloses the elements of claim 1 as noted above but fails to disclose wherein said shapes or graphical objects are dragged and dropped into said document. Arsenault discloses wherein said shapes or graphical objects are dragged and dropped into said document [Figs 7 and 27]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Randall and Price to include

Art Unit: 2161

wherein said shapes or graphical objects are dragged and dropped into said document as taught by Arsenault for the purpose of sculpting a shape by dragging and dropping objects on the screen with a mouse [col 21, line 65 through col 22, line 16]. The skilled artisan would have been motivated to modify the combination of Randall and Price per the above in order to provide a convenient graphical user interface for computer aided design.

Claim 12:

The combination of Randall and Price discloses the elements of claim 11 as noted above but fails to disclose wherein said shapes or graphical objects are dragged and dropped into said document. Arsenault discloses wherein said shapes or graphical objects are dragged and dropped into said document [Figs 7 and 27]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Randall and Price to include wherein said shapes or graphical objects are dragged and dropped into said document as taught by Arsenault for the purpose of sculpting a shape by dragging and dropping objects on the screen with a mouse [col 21, line 65 through col 22, line 16]. The skilled artisan would have been motivated to modify the combination of Randall and Price per the above in order to provide a convenient graphical user interface for computer aided design.

Claims 4, 7, 9, 14, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Randall and Price and further in view of US Pat 6,345,288 issued to Reed et al (hereafter Reed).

Claim 4:

Art Unit: 2161

The combination of Randall and Price discloses the elements of claims 1 and 3 as noted above but fails to disclose creating a form using said information associated with each page. Reed discloses creating a form using said information associated with each page [Fig 14 and col 35, lines 48-65]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Randall and Price to include creating a form using said information associated with each page as taught by Reed for the purpose of creating a search form [col 35, lines 48-65]. The skilled artisan would have been motivated to modify the combination of Randall and Price per the above such that the user is provided with a convenient means for entering information [col 35, lines 47-65].

Claim 7:

The combination of Randall, Price and Reed discloses the elements of claims 1, 3 and 4 as noted above and furthermore, Randall discloses sending created forms via email to the user [paragraph 217]

Claim 9:

The combination of Randall, Price and Reed discloses the elements of claims 1, 3 and 4 as noted above and furthermore, Randall discloses receiving a document via email [paragraph 217]

Claim 14:

The combination of Randall and Price discloses the elements of claims 11 and 13 as noted above but fails to disclose creating a form using said information associated with each page. Reed discloses creating a form using said information associated with each page [Fig 14 and col 35, lines 48-65]. It would have been obvious to one of ordinary skill in the art at the time

Art Unit: 2161

the invention was made to modify the combination of Randall and Price to include creating a form using said information associated with each page as taught by Reed for the purpose of creating a search form [col 35, lines 48-65]. The skilled artisan would have been motivated to modify the combination of Randall and Price per the above such that the user is provided with a convenient means for entering information [col 35, lines 47-65].

Claim 17:

The combination of Randall, Price and Reed discloses the elements of claims 11, 13 and 14 as noted above and furthermore, Randall discloses sending created forms via email to the user [paragraph 217]

Claim 19:

The combination of Randall, Price and Reed discloses the elements of claims 11, 13 and 14 as noted above and furthermore, Randall discloses receiving a document via email [paragraph 217]

Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Randall, Price and Reed and further in view of Pub No US 2002/0116363 issued to Grainger (hereafter Grainger).

Claim 5:

The combination of Randall, Price and Reed discloses the elements of claims 1, 3 and 4 as noted above but fails to disclose a form number. Grainger discloses a form number [paragraph 98]. It would have been obvious to one of ordinary skill in the art at the time the

Art Unit: 2161

invention was made to modify the combination of Randall, Price and Reed to include a form number as taught by Grainger for the purpose of positively identifying the form. The skilled artisan would have been motivated to modify the combination of Randall, Price and Reed per the above for the purpose of assisting the examiner in selecting the correct form such that an Office Action can be speedily and accurately completed [paragraph 98].

Claim 15:

The combination of Randall, Price and Reed discloses the elements of claims 11, 13 and 14 as noted above but fails to disclose a form number. Grainger discloses a form number [paragraph 98]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Randall, Price and Reed to include a form number as taught by Grainger for the purpose of positively identifying the form. The skilled artisan would have been motivated to modify the combination of Randall, Price and Reed per the above for the purpose of assisting the examiner in selecting the correct form such that an Office Action can be speedily and accurately completed [paragraph 98].

Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Randall, Price and Reed and further in view of US Pat 6,434,604 issued to Harada et al (hereafter Harada)

Claim 6:

The combination of Randall, Price and Reed discloses the elements of claims 1, 3 and 4 as noted above but fails to disclose each form includes a form identification bubble. Harada discloses a form identification bubble [Fig 7]. It would have been obvious to one of ordinary

Art Unit: 2161

skill in the art at the time the invention was made to modify the combination of Randall, Price and Reed to include a form identification bubble as taught by Harada for the purpose of providing a convenient means for a user to enter an identification number.

Claim 16:

The combination of Randall, Price and Reed discloses the elements of claims 11, 13 and 14 as noted above but fails to disclose each form includes a form identification bubble. Harada discloses a form identification bubble [Fig 7]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Randall, Price and Reed to include a form identification bubble as taught by Harada for the purpose of providing a convenient means for a user to enter an identification number.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Application/Control Number: 10/081,006
Art Unit: 2161

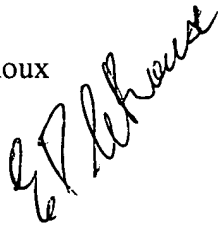
Page 13

Patent related correspondence can be forwarded via the following FAX number (703)

872-9306

Etienne LeRoux

3/9/2005

A handwritten signature in black ink, appearing to read "Etienne LeRoux", written diagonally across the printed name and date.